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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,927	11/06/2000	David D. Kloba	1933.0010009	8134
26111 7590 04/11/2007 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER FABER, DAVID	
			ART UNIT 2178	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/11/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/705,927

Applicant(s)

KLOBA ET AL.

Examiner

David Faber

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-13, 16-22 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 and 30 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 8, 10-13, 16, 17, 19-22, 25, 26 and 29 is/are rejected.
- 7) ☒ Claim(s) 9, 18, and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This office action is in response to the Request for Continued Examination filed on 29 January 2007.
2. Claims 1, 10, 19, and 29 are amended.
3. The objection of Claim 29 has been withdrawn necessitated by the amendment. The rejection of Claims 1-27 under 35 U.S.C. 112, first paragraph, has been withdrawn based on Applicant's arguments that were fully considered and persuasive.
4. Claims 1-4, 7-13, 16-22, and 25-30 are pending. Claims 1, 10, 19, and 28-30 are independent claims.

### ***Information Disclosure Statement***

5. The information disclosure statement filed 9/19/2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Page 2 - Other Art: AR2, Page 9 - Other Art: AT9, Page 11 - Other Art: AR11, Page 18 - Other Art: AR18 and AT18, Page 23 - Other Art: AT23, Page 27 - Other Art: AS27, Page 29 - Other Art: AT29, Page 30 - Other Art: AR30, Page 31 - Other Art: AT31, Page 34 - Other Art: AT34, Page 36 - Other Art: AS36, and Page 37 - Other Art: AR37 fail to list the pertinent page(s) of the source. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the

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time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Claim Objections***

6. Claim 10 is objected to because of the following informalities:
7. Claim 10 recites a "first means" and "second means" on a couple of the claim limitations without any of the other limitations reciting a number means (third means, fourth means, etc) in front of each of the limitations. Examiner believes the placement of first and second in front of means was typographical error.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 10-13, 16-18, and 29 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**For your reference, below is a section from MPEP 2105 :**

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se  
Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure

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and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.

10. Claims 10 and 29 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to be claiming "software systems" i.e. systems without hardware indication, which is a computer program per se. Since the claims disclose computer program per se that is not embodied on a computer readable medium, they appear non-statutory.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-3, 7-8, 10-12, 16-17, 19-21, and 25-26 remain rejected under 35

U.S.C. 103(a) as being unpatentable over Whitledge et al (US Patent #6,925,595, filed 10/5/1998) in further view of Burkett et al (US Patent #6,671,853, filed 7/15/1999)

As per independent Claim 1, Whitledge et al discloses a method comprising:

- Determining layout and rendering parameters based on mobile device information (e.g., Column 8, lines 5-15: Discloses obtaining device-conversion preferences that are to be used to convert an original electronic document into converted electronic document that would allow it to be displayed on a smaller display with a lower resolution, which includes a PDA (Column 21, lines 1-2) The device-conversion preferences would inherently describe the specifications of the display screen of the device which in other words, disclose the resolution, screen size and video information. )
- Parsing requesting content into a document having a format based on at least said layout and rendering parameters. (Column 8, lines 19-27: Discloses converting content based on preferences into a document. One embodiment includes parsing content into a document that includes converting the content based on the conversion preferences. (Column 23, lines 9-40; FIG 8B)
- Generating a document content on an object-by-object basis from said document. (Column 21, line 11 - Column 23, lines 40; FIG 8B: Discloses conversion of objects into a converted document by per object including

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changing each text element to Arial, and change the color and size of the image.)

- Generating a document table based on said object-by-object basis for said document content. (Column 24, lines 35-40: Discloses in a embodiment where selected, wherein selected can be all, hypertext elements references (points to the elements) are saved into a symbol table so they can used in other expression or documents.
- transmitting said content stream to a mobile device. (Column 8, lines 29-34, 40-47)

Whitledge et al fails to specifically disclose serializing said document content into a content stream according to said object-by-object basis wherein said content stream includes a plurality of objects and serializing said document table into said content stream according to said object-by-object basis. However, Burkett et al discloses parsing a document into DOM trees and having the tree be streamed into a binary format in which the streamed objects are known as serialized objects. In addition, any embedded or referenced objects are processed recursively during the process. (Column 3, lines 1-26; line 64 – Column 4, line 2) Furthermore, Burkett et al states the streaming process includes identifying portions or fragments of a document wherein the fragments are written into a serialized binary format, thus containing all the fragments or objects are in the content stream. (Abstract, lines 5-10) Therefore, a plurality of objects are presented in the content stream when the fragments are parsed and streamed as

serialized binary data. When finished, the stream is written onto a communications channel. (Column 3, lines 1-26; line 64 – Column 4, line 2) Whitledge et al discloses an embodiment in by parsing a document first into a DOM tree, and creating a table comprising object references before converting the document. (FIG 9-12, Column 24, lines 9- Column 25, lines 67)

It would have been obvious to one of ordinary skill in the art at the Applicant's invention to have combined Whitledge et al and Barron methods with Burkett et al's methods since Burkett et al's method would have provided the benefit of wherein documents encoded can be more efficiently processed.

Furthermore, Whitledge et al and Burkett et al fail to specifically disclose the serial document table contains at least one pointer to object data in the content stream. However, Burkett et al discloses that the serialized stream represents a "flattened" version of the object that getting serialized, wherein contains information about the original structure of the object. (Column 3, lines 17-20) Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention when Whitledge et al's method of generating a document table that contains references (pointers) using Burkett's serialization method into a content stream, Whitledge et al's document table containing pointers would remain intact for transporting since serialization allows transporting of data to different hardware configurations and does not suffer from the problems of byte ordering, memory layout, or simply different ways of representing data structures in different programming languages.



As per dependent Claim 2, Whitledge et al discloses a method wherein said object-by-object basis corresponds to distinguishable pieces of request content. (Column 21, line 11 - Column 23, lines 40; FIG 8B: Discloses different objects, text and images, are identified as text and images making them distinguishable.)

As per dependent Claim 3, Whitledge et al discloses a method wherein said document table provides points of reference to the objects of said document content (Column 24, lines 35-40: Discloses in a embodiment where selected, wherein selected can be all, hypertext elements references (points to the elements) are saved into a symbol table so they can used in other expression or documents.

As per dependent Claim 7, Whitledge et al discloses said storing said content stream to a mobile device. (Column 8, lines 29-34; 40-47: Discloses receiving a converted document wherein when the document is received, its inherently saved to temporary memory buffer for further operation.)

As per dependent Claim 8, Claim 8 recites similar limitations as in Claim 1 and Claim 2 and is rejected under rationale. Furthermore, Whitledge et al discloses a method comprising modifying an object of said content stream, wherein said object corresponds to distinguishable pieces of said requested content. (Column 23, lines 9-54: Discloses content, such as image, being altered or modify to accustom to the PDA device conversion preferences during the process being received by the PDA.)

As per independent claim 10, Claim 10 recites a system for performing the method of Claim 1 and is similar rejected under rationale.

As per dependent claim 11, Claim 11 recites similar limitations as in Claim 2, and is similarly rejected under rationale.

As per dependent claim 12, Claim 12 recites similar limitations as in Claim 3, and is similarly rejected under rationale.

As per dependent claim 14, Claim 14 recites similar limitations as in Claim 5, and is similarly rejected under rationale.

As per dependent claim 15, Claim 15 recites similar limitations as in Claim 6, and is similarly rejected under rationale.

As per dependent claim 16, Claim 16 recites similar limitations as in Claim 7, and is similarly rejected under rationale.

As per dependent claim 17, Claim 17 recites similar limitations as in Claim 8, and is similarly rejected under rationale.

As per independent claim 19, Claim 19 recites a computer program product... for performing the method of Claim 1 and is similar rejected under rationale.

As per dependent claim 20, Claim 20 recites similar limitations as in Claim 2, and is similarly rejected under rationale.

As per dependent claim 21, Claim 21 recites similar limitations as in Claim 3, and is similarly rejected under rationale.

As per dependent claim 23, Claim 23 recites similar limitations as in Claim 5, and is similarly rejected under rationale.

As per dependent claim 24, Claim 24 recites similar limitations as in Claim 6, and is similarly rejected under rationale.

As per dependent claim 25, Claim 25 recites similar limitations as in Claim 7, and is similarly rejected under rationale.

As per dependent claim 26, Claim 26 recites similar limitations as in Claim 8, and is similarly rejected under rationale.

13. Claims 4, 13, and 22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Whitley et al (US Patent #6,925,595, filed 10/5/1998) in further view of Burkett et al (US Patent #6,671,853, filed 7/15/1999) in further in view of Barron (US Patent #6,665,709, filed 3/27/2000).

As per dependent Claim 4, Whitley et al discloses compressing said document content according to said object-by-object basis (Column 23, lines 9-54: Discloses image size being reduced or compressed of its original size to be able to meet the conversion preferences.)

However, Whitley et al fails to specifically disclose encrypting said document content according to said object-by-object basis. However, Barron discloses a method of encrypting electronic data into an encrypted data packet. (Column 6, Claim 1, line 48-49).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Whitley et al's method with Barron's method

since Barron's method would have facilitated virtually impregnable security for the delivery, storage and sharing of documents and files.

As per dependent claim 13, Claim 13 recites similar limitations as in Claim 4, and is similarly rejected under rationale.

As per dependent claim 22, Claim 22 recites similar limitations as in Claim 4, and is similarly rejected under rationale.

### ***Allowable Subject Matter***

14. Claims 9, 18, and 27 remain objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Claim 29 would still be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

16. Claims 28, and 30 remain are allowed.

### ***Response to Arguments***

17. Applicant's arguments filed 29 January 2007 have been fully considered but they are not persuasive.

18. On pages 11-12 in regards to the Information Disclosure Statement filed by the Applicant on 9/19/01, Applicant argues the "relevant pages of the publication" requirement of 37 C.F.R. 1.98 (b)(5) is not relevant in the case of the documents at

issue since the documents are either internet World Wide Web pages printed out or press releases. However, the Examiner disagrees.

Examiner respectfully discloses in the event the documents are either internet World Wide Web pages printed out or press releases, the Applicant must provide the number of pages printed from the World Wide Web source to fulfill the relevant pages of the publication requirement.

19. On pages 13-14 in regards to claims 10-13, 16-18, and 29 rejected under 35 U.S.C. 101, Applicant argues that claims 10 and 29 are directed toward statutory subject matter wherein the Applicant refers to the specification in which an appropriate structure is disclosed corresponding to the claim language in claims 10 and 19 in that the specification discloses a server. Applicant argues the server described in the specification provides "hardware indication" to the systems recited in claims 10 and 29. However, the Examiner disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., server) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claims 10 and 29 disclose a system of structuring interactive content for mobile devices wherein the claims themselves as written fail to disclose any form of hardware indication since the claims do not disclose the use of a server. Therefore, the claims,

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themselves, lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory. They are, at best, functional descriptive material per se. Thus, in regards to claims 10-13, 16-18, and 29, the claims, as written, appear to be claiming "software systems" i.e. systems without hardware indication, which is computer program per se. The claims as written do not recite any hardware indication.

20. On pages 14-15 in regards to the independent claims, Applicant argues Burkett fails to specifically teach or suggest the limitation "serializing said document content into a content stream according to said object-by-object basis wherein said content stream includes a plurality of objects" wherein Burkett fails to disclose the content stream includes a plurality of objects. However, the Examiner disagrees.

Burkett et al discloses parsing a document into DOM trees and having the tree be streamed into a binary format in which the streamed objects are known as serialized objects. In addition, any embedded or referenced objects are processed recursively during the process. (Column 3, lines 1-26; line 64 – Column 4, line 2) Furthermore, Burkett et al states the streaming process includes identifying portions or fragments of a document wherein the fragments are written into a serialized binary format, thus containing all the fragments or objects are in the content stream. (Abstract, lines 5-10,

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Column 4, lines 17-21) Therefore, a plurality of objects are presented in the content stream when the fragments are parsed and streamed as serialized binary data.

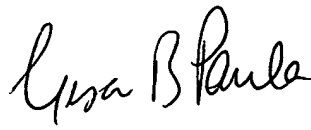
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Faber  
Patent Examiner  
AU 2178

A stylized handwritten signature consisting of the letters 'D' and 'F' joined together.A handwritten signature in cursive script that reads 'Cesar Paula'.

**CESAR PAULA  
PRIMARY EXAMINER**